

REMARKS

Applicant has reviewed and considered the Office Action mailed on March 27, 2002, and the references cited therewith. Claims 1, 8, 12, and 26 are amended. Claims 1-34 are pending in this application. Applicant respectfully requests reconsideration of the above-identified application in view of the amendments above and the remarks that follow.

§102 Rejection of the Claims

Claims 1, 2, and 4-6 were rejected under 35 USC § 102(a) as being anticipated by Verhines (U.S. 5,996,130).

Claim 1 has been amended to better describe the subject matter recited in the claim.

Applicant submits that claim 1 is not anticipated by the Verhines reference since the reference does not include each limitation recited in the claim. For instance, Applicant cannot find in Verhines a label including a first layer and a “second layer including a non-adhesive label material” which is permanently attached to the second surface of the first layer, and “the second layer comprising a first section and a second section having a gap therebetween, said gap defining a fold-line section in the first layer, . . . wherein when a folding pressure is applied to the label, the label folds along the fold-line section.”

In contrast, Verhines discusses a tab sheet assembly having a tab material 74 and an adhesive 82, 90. There appears to be no motivation or suggestion to provide the claimed subject matter in the Verhines reference. The Verhines reference operates under a completely different principle than the folding label of the present claim. The Verhines reference deals with a tab 74 which, in use, is already connected to sheet 62. The tab is configured such that a user can unfold and re-attach the tab after the sheet has gone through a printer. This leads away from the present claim which is directed to a label including a first layer and a second layer having a gap defining a fold-line section in the first layer, “wherein when a folding pressure is applied to the label, the label folds along the fold-line section.” This type of folding label is not discussed or suggested by the Verhines reference, which folds along a fold-line 114, and not along a gap when a folding pressure is applied.

Claims 2 and 4-6 include each limitation of parent claim 1 and are therefore also not

anticipated by the Verhines reference. Reconsideration and allowance is respectfully requested.

§103 Rejection of the Claims

Claims 3, and 7-34 were rejected under 35 USC § 103(a) as being unpatentable over Verhines (U.S. Patent No. 5,996,130), as used above. In addition to the remarks below, Applicant respectfully traverses the single reference rejection under 35 U.S.C. § 103 since not all of the recited elements of the claims are found in the Verhines reference. Since all the elements of the claim are not found in the reference, Applicant assumes that the Examiner is taking official notice of the missing elements. Applicant respectfully objects to the taking of Official Notice with a single reference obviousness rejection and, pursuant to M.P.E.P. § 2144.03, Applicant respectfully traverses the assertion of Official Notice and requests that the Examiner cite references in support of this position.

Claims 3 and 7-10

Claims 3 and 7-10 include each limitation of parent claim 1 and therefore are not obvious over Verhines for the reasons given above for claim 1 since there is no suggestion or motivation to provide the subject matter of claim 1 in the Verhines reference.

Moreover, regarding claim 8, Applicant traverses the assertion that it "would have been an obvious matter of design choice to modify the second layer of the Verhines reference to be whatever thickness desired, such that the second layer does not bend when a folding pressure is applied." Applicant traverses since, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP § 2143.01. In this case, the Examiner points to the adhesive 82, 90 of Verhines as the second layer. However, in use, adhesive 82 bends along fold-line 114 when the tab 74 is configured onto the sheet. (See Figs. 3, 5, 6a and 6b, and accompanying discussion). If adhesive 82 were so thick that it could not bend at line 114 when a bending pressure were applied, then the tabs 74 could not be put on the sheets correctly. This would defeat the purpose of the Verhines disclosure. Accordingly, the Verhines reference teaches away from such a

modification since it would render the tab sheet assembly unsuitable for its stated purpose.

Reconsideration and allowance of claims 3 and 7-10 is respectfully requested.

Claims 11-21

Applicant traverses the obviousness rejection of claim 11. Applicant respectfully submits that the Office Action did not make out a *prima facie* case of obviousness since the Verhines reference fail to teach or suggest all of the elements of applicant's claim. Applicant notes that to support a *prima facie* case of obviousness, the reference must teach or suggest all the claim elements. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

As admitted by the Office Action, the Verhines reference does not discuss a gap being discernible through the first layer. However, the Office Action states that it "would have been obvious to provide the first layer with a desired material (such as a transparent plastic) that would enable the gap to be viewed through the first layer, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice." Applicant traverses this matter-of-design-choice rejection. The Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine or modify reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2D 1430 (Fed. Cir. 2002). The present rejection is a mere conclusory statement of subjective belief, so Applicant respectfully submits that the Office Action has not provided objective evidence for a suggestion or motivation to modify the reference.

Moreover, the recited limitation is discussed in the present application at page 6, lines 8-9, where it is discussed that the discernible gap allows the label to be visually aligned with the edge of a stock member when a user is applying the label. The discernible gap of the claimed label allows the user to predict where the label will fold and this allows the user to align the label without having to look at the back of the label each time to see where it will fold. Since the limitation has been pointed out to provide an advantage over the prior art, Applicant believes the present rejection is not supported under MPEP 2144.04, which states "[i]f the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on

case law as the rationale to support an obviousness rejection."

Claims 12-21 include each limitation of parent claim 11 and are therefore also not obvious over the Verhines reference for the reasons stated above. Moreover, applicant traverses the Examiner's reliance on case law to support the obviousness rejection of claims 12 and 13 "as a matter of design choice," for the reasons stated above for claim 11. Reconsideration and allowance is respectfully requested.

Claims 22-25

Claim 22 includes similar limitations as claim 11 and is not obvious over the Verhines reference for similar reasons as discussed above for claim 11. For instance, Claim 22 recites a label which includes a first layer having a top surface adapted to being printed on and a bottom surface, and a second layer attached to the bottom surface of the first layer, the second layer comprising two or more sections, wherein between each of the two or more sections is a gap, each gap defining a fold-line section in the first layer, "the second layer comprising a darker material than the first layer, wherein each gap is discernible through the first layer and indicates the fold-line section of the first layer, the first layer folds along the fold-line section when a folding force is applied to the label." The discussion for claim 11 above is incorporated herein by reference.

Claims 23-25 include each limitation of parent claim 22 and are therefore also not obvious over the Verhines reference. Reconsideration and allowance is respectfully requested.

Claims 26-29

Applicant has amended claim 26 to better describe the subject matter recited in the claim. Applicant submits that the claim is not obvious over the cited reference since there is no motivation or suggestion to modify the reference to include the subject matter of the claim. The present claim recites a label form which includes a backing member, a first layer having a top surface adapted to being printed on, "a second layer including a non-adhesive label material which is permanently attached to the first layer," and "wherein, when the label has been removed from the backing member and a folding pressure is applied to the label, the label folds along the

foldable section such that one section of the second layer is attachable to a first side of the stock member and a second section of the second layer is attachable to a second side of the stock member.”

In contrast, the Verhines reference includes a tab 74 having an adhesive 82, 90.

Moreover, the reference operates under a completely different principle than the folding label of the present claim. As discussed above, the Verhines reference deals with tab 74 which, in use, is already connected to sheet 62 by adhesive 82, 90. The tab is configured such that a user can unfold and re-attach the tab after the sheet has gone through a printer. The present claim is directed to a label including a first layer and a second layer having a gap defining a fold-line section in the first layer, “wherein when the label has been removed from the backing member and when a folding pressure is applied to the label, the label folds along the fold-line section.” This type of folding label is not discussed or suggested by the Verhines reference, which folds along a fold-line 114, and not along a gap, and which, in use, does not use a backing member.

Claims 27-29 include each limitation of parent claim 26 and are therefore also not obvious over the Verhines reference. Reconsideration and allowance is respectfully requested.

Claims 30-31

Applicant traverses the rejection of claims 30-31 since there is no suggestion or motivation to modify the Verhines reference to include the subject matter of the claims. Claim 30 includes similar limitations as claim 11 and is not obvious over the Verhines reference for similar reasons as discussed above for claim 11. For instance, claim 30 recites “aligning the label such that a discernible gap of the label is aligned with an edge of the stock member,” applying a first portion of the label to a first side of the edge of the stock member, and “folding the label along the discernible gap” which is defined by a weakened fold-line running along a surface of the label. Again, Applicant submits that since the discernable gap limitation provides advantages as described in the application, it is not permissible to rely on a rationale based on matter of design choice. The discussion for claim 11 is incorporated herein by reference.

Claims 32-33

Claims 32-33 contain similar elements as claim 33 and are not obvious over the Verhines for similar reasons as discussed above.

Claim 34

Claim 34 includes similar limitations as claim 11 and is not obvious over the Verhines reference for similar reasons as discussed above for claim 11. For instance, Claim 34 recites a label which includes “a second layer including a first section and a second section at least partially separated by a gap which is visually discernible through the first layer, wherein the label folds along the visually discernible gap such that a user folding the label can predict where the label will fold by perceiving the visually discernible gap through the first layer.” The discussion for claim 11 is incorporated herein by reference. Reconsideration and allowance is respectfully requested.

AMENDMENT & RESPONSE UNDER 37 C.F.R. § 1.116 - EXPEDITED PROCEDURE

Serial Number: 09/690,667

Filing Date: October 17, 2000

Title: LABEL HAVING FOLDING FEATURE

Page 13
Dkt: 224.013US1

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney ((612) 359-3267) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

STEVEN MACWILLIAMS

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 359-3267

Date 5/28/02

By *Peter C. Maki*

Peter C. Maki
Reg. No. 42,832

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Box AF, Commissioner of Patents, Washington, D.C. 20231, on this 28th day of May, 2002.

Sarah L. Reinhard
Name

Sarah L. Reinhard
Signature